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In re Application of
PLUNDRICH, Winfried *et al*
Application No.: 09/890,235
PCT No.: PCT/DE00/00170
Int. Filing Date: 20 January 2000
Priority Date: 28 January 1999
Attorney's Docket No.: 449122007600
For: COMPOSITE OF TWO PARTS
FORMED USING A GLUE

**DECISION ON RENEWED
PETITION TO WITHDRAW
HOLDING OF ABANDONMENT
AND PETITION TO REVIVE IN
THE ALTERNATIVE**

The decision is in response to applicants' "Renewed Petition to Withdraw Holding of Abandonment and Petition to Revive in the Alternative" ("Ren.Pet.") filed on 17 October 2002.

BACKGROUND

On 03 September 2002, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed. The decision was dismissed because a translation of the international application as originally filed had not yet been provided.

On 17 October 2002, applicants filed the instant renewed petition requesting that the holding of abandonment be withdrawn, or in the alternative to revive the above-captioned application pursuant to 37 CFR 1.137(b).

DISCUSSION

Petition to Withdraw Holding of Abandonment

Applicants claim that the Notification of Defective Response mailed 09 April 2002 did not adequately explain that a copy of the international application as filed was required as an adequate response because "the Notification indicated that a new translation must be furnished in compliance with 35 USC 371." Ren.Pet. at ¶ 4. Applicants contend that the statute does not specify an English translation of the original international application. *Id.* Moreover, applicants claim that "[i]t was not until Applicants received the Decision on Petition that the U.S. Patent and Trademark Office first identified 37 CFR 1.495(c)(1) as a reason for not having adequately responded to the Notification of Defective Translation." *Id.* at ¶ 6. Applicants argue that since they had no knowledge that a copy of the international application as filed was required to

respond to the Notification of Defective Response, instead, they "responded by supplying a translation of the IPER explaining the amendments made during the PCT phase of prosecution." *Id.* at 7.

This argument has been carefully considered but has been rejected.

The Notification of Defective Response mailed 09 April 2002 specifically refers to 37 CFR 1.495 on the first sentence followed by a list of items submitted by applicants to the Office pursuant to that regulation. Applicants should have known to refer to 37 CFR 1.495 if there were any questions regarding any items required still outstanding. In addition, the statute specifically expressly requests an English translation of the international application, an English translation of any amendments, and an English translation of any annexes to the IPER. See 35 U.S.C. 371(c)(2) & (3) & (5). If this requirement was ambiguous, applicants should have referred to the rules which expand and clarify the requirements outlined in the statute.

Petition to Revive Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting to revive an application on the grounds of unintentional delay must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

In this case, the proper reply required by item (1) above is to submit a translation of the international application as originally filed. Applicants have submitted this translation with the instant petition. Thus item (1) is complete. The appropriate petition fee of \$1,280 has been charged from Deposit Account No. 03-1952 as authorized. Therefore, item (2) is complete. Applicants state that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional" as required by item (3). No terminal disclaimer is required in this case. Therefore, all of the requirements of 37 CFR 1.137(b) are complete.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.181 requesting that the holding of abandonment be withdrawn is **DISMISSED**.

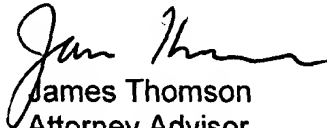
Nevertheless, the petition to revive under 37 CFR 1.137(b) requested in the alternative is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 January 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **17 October 2002**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



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